

REMARKS

Rejection of claims 1, 2, 5 – 8, 10, 11, 13, and 16 – 20 under 35 U.S.C. § 103(a) as being unpatentable over US 2004/0170263 (Michael et al.) in view of US 2003/0065788 (Salomaki), and in further view of US 2004/0234061 (Koch et al.)

Although the Examiner cited US 2004/017263 for Michael et al., Applicant presumes that the cited reference Michael was meant to refer to US 2004/0170263, as cited in the Office Action dated 06/29/2006. Therefore, Applicant responds herein with respect to US 2004/0170263.

Applicant respectfully traverses the rejection of claims 1, 2, 5 – 8, 10, 11, 13, and 16 – 20. Reconsideration is respectfully requested.

The Office Action on page 3 states that, “Michael, as modified by Salomaki, fails to explicitly disclose wherein the presence information is sent via a TCH supporting a call.” The Office Action purports to find the missing limitation in Koch, wherein Koch is directed towards a method for delivering person-to-person services to a telephone subscriber.

Applicant respectfully submits that the combination of Michael, Salomaki, and Koch does not teach or suggest all the claim limitations as set forth in independent claim 1. For example, independent claim 1 recites, “when a condition for updating the MS exists, sending, by the WPP, presence information from the buddy list presence information to update the MS, wherein the presence information is sent via a traffic channel (TCH) supporting a call involving the MS” (emphasis added), which is neither taught nor suggested in the combination of Michael, Salomaki, and Koch.

Koch on page 5, para [0063] states “... Buddy Call Waiting Service... a call from a buddy may be alerted to the subscriber when the subscriber is already engaged with

another call. If the caller is not a buddy, the caller may hear a busy tone." Koch further on page 5, para [0067] states "...SCP 140 may consult the buddy list in database ... if caller 130 is determined not to be a buddy... SCP 140 sends a default response to SSP 116 ... to play a busy tone for caller 130 ... caller 130 hears a busy tone, indicating subscriber 110 is not available to receive the call." Further, Koch on page 5, para [0068] states "... caller 130 is a buddy... SCP 140 sends a buddy response to SSP 116. The buddy response may be an Authorize_Termination message. The buddy response may also comprise a ControllingLegTreatment field. The ControllingLegTreatment field may contain a standard call waiting tone indication...SSP 116 alerts subscriber 110 with the standard calling waiting tone." However, the call waiting information about Koch's buddy calling does not teach or suggest sending presence information from the buddy list presence information to update the MS, as recited in claim 1.

Koch sends only call waiting information about the buddy calling the subscriber, not presence information, as recited in claim 1. For example, call waiting information in Koch is sent only when the buddy calls the subscriber and only pertains to the buddy and the fact that the buddy is calling. This is not true of presence information. In the example cited in Koch, call waiting information is not sent about the buddy when the buddy is not calling the subscriber. Again, this is not true of presence information. Hence, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list presence information would be sent to update the subscriber. Therefore, Koch fails to describe sending presence information for the buddy via the TCH, as recited in claim 1.

Further, Applicant's WPP maintains the updated buddy list presence information for the MSs which are subscribed to receive the information from the WPP. This presence information in Applicant's WPP is also related to the devices which are unavailable for interaction. And, presence information regarding devices which are available and devices which are unavailable is sent to the MS. However, Koch sends the call waiting information only when the caller calls the subscriber. For the above reasons,

the combination of Michael, Salomaki, and Koch fails to disclose Applicant's claimed invention as claimed in independent claim 1, Applicant respectfully requests withdrawal of the rejection of independent claim 1 under 35 USC 103(a). Applicant requests that independent claim 1 now be passed to allowance.

Dependent claims 2, 5 – 8, 10, 11, 13, and 16 – 20 depend from, and include all the limitations of independent claim 1. Therefore, Applicant respectfully requests the reconsideration of dependent claims 2, 5 – 8, 10, 11, 13, and 16 – 20 and requests withdrawal of the rejection.

Rejection of claims 3, 4, 9, and 12 under 35 U.S.C. 103(a) as being unpatentable over US 2004/0170263 (Michael et al), US 2003/0065788 (Salomaki), and US 2004/0234061 (Koch et al.), and further in view of US 2002/0129103 (Birkler et al.)

Dependent claims 3, 4, 9, and 12 depend from, and include all the limitations of independent claim 1. Therefore, Applicant respectfully requests the reconsideration of dependent claims 3, 4, 9, and 12 and requests withdrawal of the rejection.

Rejection of claims 14 and 15 under 35 U.S.C. 103(a) as being unpatentable over US 2004/0170263 (Michael et al), US 2003/0065788 (Salomaki), and US 2004/0234061 (Koch et al.), and further in view of Black.

The Examiner cites US 6,895,425 for Black as well as for Kadyk (for rejecting claim 32). However, Applicant presumes that the First Named Inventor for United States Patent No. 6,895,425 is Donald Kadyk rather than Black, according to the **Patent Application Information Retrieval System** under public pair on United States Patent and Trademark Office's official web site. Therefore, Applicant respectfully requests the Examiner to provide the United States Patent/ Publication number for the cited reference Black.

Dependent claims 14 and 15 depend from, and include all the limitations of independent claim 1. Therefore, Applicant respectfully requests the reconsideration of dependent claims 14 and 15 and requests withdrawal of the rejection.

Rejection of claims 21, 29, and 33 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.) in view of US 2004/0234061 (Koch et al.)

Applicant respectfully traverses the rejection of claims 21, 29, and 33. Reconsideration is respectfully requested.

Applicant respectfully submits that the combination of McDowell and Koch does not teach or suggest all the claim limitations as set forth in independent claims 21 and 33. For example, independent claim 21 recites, “receiving, by the MS, updated buddy list presence information via the TCH supporting the call request,” which is neither taught nor suggested in the combination of McDowell and Koch. Independent claim 33 recites, “adapted to receive an updated buddy list presence information via the TCH supporting the call request and the transceiver,” which is also neither taught nor suggested in the combination of McDowell and Koch.

For the reasons mentioned above with respect to claim 1, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list presence information would be sent to update the subscriber. Therefore, Koch fails to describe sending presence information for the buddy via the TCH supporting the call request, as claimed. Hence, the combination of McDowell and Koch do not teach or suggest the claim language of “receiving, by the MS, updated buddy list presence information via the TCH supporting the call request,” as recited by independent claim 21, nor the claim language of “adapted to receive an updated buddy list presence information via the TCH supporting the call request and the transceiver,” as recited by independent claim 33. Therefore, the Applicant respectfully requests withdrawal of the rejection of independent claims 21 and 33 under 35 U.S.C. 103.

Dependent claim 29 depends from, and includes all the limitations of independent claim 21. Therefore, Applicant respectfully requests the reconsideration of dependent claims 21 and requests withdrawal of the rejection.

Rejection of claims 22 – 28 and 30 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.) and US 2004/0234061 (Koch et al.), and further in view of US 2002/0129193 (Birkler et al.)

Dependent claims 22 – 28 and 30 depend from, and include all the limitations of independent claim 21. Therefore, Applicant respectfully requests the reconsideration of dependent claims 22 – 28 and 30 and requests withdrawal of the rejection.

Rejection of claim 31 under 35 U.S.C. § 103(a) as being unpatentable over US 2002/0035605 (McDowell et al.), US 2004/0234061 (Koch et al.), and US 2002/0129193 (Birkler et al.), and further in view of US 2003/0073440 (Mukherjee et al.)

Dependent claim 31 depends from, and includes all the limitations of independent claim 21. Therefore, Applicant respectfully requests the reconsideration of dependent claims 21 and requests withdrawal of the rejection.

Rejection of claim 32 under 35 U.S.C. 103(a) as being unpatentable over US 6,895,425 (Kadyk et al) in view of US 2003/0065788 (Salomaki), and further in view of US 2004/0234061 (Koch et al.)

The Examiner cites US 6,895,425 for Black as well as for Kadyk (for rejecting claim 32). However, Applicant presumes that the First Named Inventor for United States Patent No. 6,895,425 is Donald Kadyk rather than Black, according to the **Patent Application Information Retrieval** under public pair on United States Patent and Trademark Office's official web site. Therefore, Applicant responds herein with respect to US 6,895,425 for Kadyk.

Applicant respectfully traverses the rejection of claim 32. Reconsideration is respectfully requested.

Applicant respectfully submits that the combination of Kadyk, Salomaki, and Koch does not teach or suggest all the claim limitations as set forth in independent claim 32. For example, independent claim 32 recites, "adapted to send, via the network interface and a traffic channel (TCH) supporting a call involving the MS, presence information from the buddy list presence information to update the MS, when a condition for updating the MS exists," which is neither taught nor suggested in the combination of Kadyk, Salomaki, and Koch.

For the reasons mentioned above with respect to claim 1, there is no teaching or suggestion provided in Koch, as cited, that presence information from the buddy list presence information would be sent to update the subscriber. Therefore, Koch fails to describe sending presence information for the buddy via the TCH supporting the call, as claimed. Hence, the combination of Kadyk, Salomaki, and Koch do not teach or suggest the claim language of "adapted to send, via the network interface and a traffic channel (TCH) supporting a call involving the MS, presence information from the buddy list presence information to update the MS, when a condition for updating the MS exists," as

recited by independent claim 32. Therefore, the Applicant respectfully requests withdrawal of the rejection of independent claim 32 under 35 U.S.C 103.

Conclusion

Since none of the references cited, either independently or in combination, teach all of the limitations of the independent claims, or therefore, all the limitations of their respective dependent claims, it is asserted that neither anticipation nor a prima facie case for obviousness has been shown. Thus, Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Such action is earnestly solicited by the Applicant. Should the Examiner have any questions, comments, or suggestions, the Examiner is invited to contact the Applicant's attorney at the telephone number indicated below.

Lastly, please charge any additional fees (including extension of time fees) or credit overpayment to Deposit Account No. **502117 -- Motorola, Inc.**

Respectfully submitted,

By: /Jeffrey K. Jacobs/
Jeffrey K. Jacobs
Attorney for Applicant
Registration No. 44,798
Tel. No. (847) 576-5562
Fax No. (847) 576-3750